

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JAMES RICHARD WASON

Appeal 2007-1186
Application 09/616,809¹
Technology Center 2100

Decided: November 20, 2007

Before ALLEN R. MACDONALD, JAY P. LUCAS,
and SCOTT R. BOALICK, *Administrative Patent Judges*.

BOALICK, *Administrative Patent Judge*.

DECISION ON REQUEST FOR REHEARING

Appellant requests rehearing under 37 C.F.R. § 41.52 of that portion of our Decision on Appeal entered June 18, 2007 ("Decision") wherein we affirmed the Examiner's final rejection of claims 14-16 under 35 U.S.C. § 102(e). Appellant does not request rehearing of that portion of our

¹ Application filed July 14, 2000. The real party in interest is International Business Machines Corporation.

Decision in which we affirmed the Examiner's final rejection of claims 1-3, 5-13, and 17 under 35 U.S.C. § 102(e).

The request for rehearing is granted-in-part.

DISCUSSION

Appellant argues that our Decision misapprehended or overlooked two points in affirming the rejection of claims 14-16.² We do not agree.

First, Appellant argues that our Decision did not apply the proper test for anticipation because our statement of the issue on page 5 of the Decision "stated that the 'issue turns on the interpretation of claim 1 and whether Andrews describes or suggests each and every limitation of the claims' (Decision 5, ll. 2-4.) (emphasis added)." (Req. for Reh'g 2.)

We do not agree that our Decision applied an incorrect test for anticipation. The proper test for anticipation was explained on pages 9 and 10 of the Decision, and is reproduced below:

Anticipation is established when a single prior art reference discloses expressly or under the principles of inherency each and every limitation of the claimed invention. *Atlas Powder Co. v. IRECO Inc.*, 190 F.3d 1342, 1347, 51 USPQ2d 1943, 1946 (Fed. Cir. 1999); *In re Paulsen*, 30 F.3d 1475, 1478-79, 31 USPQ2d 1671, 1673 (Fed. Cir. 1994).

Under the principles of inherency, a reference anticipates if it necessarily includes or functions in accordance with the claimed limitations. *Atlas Powder Co. v. IRECO Inc.*, 190 F.3d at 1347, 51 USPQ2d at 1946. Inherency may be established by extrinsic evidence, but "[s]uch

² Appellant states that claim 14 is representative of claims 15 and 16. (Req. for Reh'g 1.)

evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill." *Continental Can Co. v. Monsanto Co.*, 948 F.2d 1264, 1268, 20 USPQ2d 1746, 1749 (Fed. Cir. 1991). Inherency may not be established by probabilities or possibilities, and "[t]he mere fact that a certain thing may result from a given set of circumstances is not sufficient." *Id.*

(Decision 9-10.) In addition, we note that "[a] reference anticipates a claim if it discloses the claimed invention 'such that a skilled artisan could take its teachings in combination with his own knowledge of the particular art and be in possession of the invention.'" *In re Graves*, 69 F.3d 1147, 1152 (Fed. Cir. 1995) (quoting *In re LeGrice*, 301 F.2d 929, 936 (CCPA 1962)).

Our analysis applied the proper test for anticipation with respect to claims 14-16 at pages 12-13 of the Decision.

However, because the phrase "describes or suggests" in the first paragraph on page 5 of the Decision may be unclear, we will modify the original Decision to the extent of replacing that phrase with the phrase "discloses expressly or under the principles of inherency." We decline to otherwise modify our Decision.

Second, Appellant argues that Andrews "does not show passing to the macro class a name for another template, which is subsequently invoked by the macro class, when the macro class is invoked." (Req. for Reh'g 3 (emphasis in original).) In particular, with respect to Figure 6 of Andrews Appellant argues that "there is no indication that this term ["part'n"] is passed to the macro when the macro itself is invoked." (Req. for Reh'g 6.) Appellant also argues that "it does not follow that it is inherent that the name

[of the partition template] was passed to the macro when the macro is invoked. That name, for example, could be passed to the macro before the macro is invoked." (Req. for Reh'g 6.)

Here, Appellant appears to merely reargue points that we considered and addressed in our original Decision at pages 12-13, where we found that Andrews teaches the limitations of claim 14 both expressly and under the principles of inherency. Our findings are further buttressed by the teachings in Andrews that:

(1) a macro "is invoked **whenever** a designated symbol is used anywhere within the computer program. Thus, the symbol 'ID' can be defined to be a macro such as 'average(b+daytime, array[15])' so that **whenever** the symbol 'ID' appears in the program, it will be substituted for its definition (i.e., a 'macro expansion')." (Andrews, col. 1, ll. 58-66 (emphasis added).)

and

(2) "macros can be defined to accept parameters that, in turn, need to be inserted in the definition of the macro **when** it is expanded." (Andrews col. 2, ll. 1-3 (emphasis added).)

Thus, Appellant has not established error in our findings regarding Andrews. Accordingly, we decline to modify our Decision.

CONCLUSION

The request for rehearing is granted to the extent that our original Decision of June 18, 2007 is modified to replace the phrase "describes or suggests" with the phrase "discloses expressly or under the principles of inherency" in the first paragraph on page 5, but is otherwise denied.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

GRANTED-IN-PART

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